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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/923,923 | 08/07/2001 | Richard D. Martin | 401-13U1 | 9008 |

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2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

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| EXAMINER |
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MARTIN, NICHOLAS A

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| ART UNIT | PAPER NUMBER |
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2154

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,923

Applicant(s)

MARTIN ET AL.

Examiner

Nicholas A. Martin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/7/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/7/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1-24 are presented for examination.

Drawings

2. The drawings are objected to because they fail to include reference characters pertaining to each particular part of the necessary figures (i.e.: Figures 1-3 and 15A-16). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following:

3. Pertaining to Figures 1-20, there are no reference characters mentioned as per each drawing's particular parts.
4. On page 6, line 26, it states "... self-explanatory" in regards the explanation of Figure 2. This is objected to because each particular part of a drawing (where applicable) should be explained. Subsequent duplications of "self-explanatory" are also objected to.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-11, 13, 15-17, 19-21 and 23-24 are rejected under 35 U.S.C. 102(e) as being unpatentable as being anticipated by Call, Charles G. (hereinafter Call), US 6,418,441.

6. As per claim 1, Call teaches a method of obtaining selected content for a web page, wherein the selected content itself is not initially part of the web page, the web page including script associated with the selected content, the method comprising:

(a) a web browser requesting a web page that includes script associated with the selected content (Col. 2, lines 18-29); and

(b) the web browser interpreting the script and formatting a request for obtaining the selected content from a remote site, the request including a uniform resource identifier (URI) of the web page and a unique identifier of the selected content (Col. 2, lines 40-48; Col. 15, lines 39-52; Col. 21, lines 43-48).

7. As per claim 2, Call teaches a method of claim 1, further comprising:

(c) a remote site receiving the request and authenticating whether the URI is authorized to receive the selected content (Col. 6, lines 10-14, lines 43-55), and, if so, the remote site locating the selected content, and sending the selected content to the web browser (Col. 17, lines 65-67; Col. 18, lines 1-10, lines 52-58); and

(d) the web browser assembling the initially requested web page using the selected content obtained from the remote site (Col. 23, lines 3-8, and lines 51-55).

8. As per claim 3, Call teaches the method of claim 2, wherein the remote site is a web server, and the selected content is stored in a content repository connected to the web server (Col. 6, lines 44-52).

9. As per claim 4, Call teaches the method of claim 2, wherein the selected content includes two or more different selected content, each selected content being used for different parts of the web page, wherein each selected content has its own script for implementing steps (b)-(d) (Col. 3, lines 1-7; Col. 28, lines 46-58).

10. As per claim 5, Call teaches the method of claim 2, wherein in step (c), if the URI is not authorized to receive the selected content, the remote site sends a signal to the web browser that the selected content is not available, and the web browser assembles the web page without the selected content (Col. 19, lines 28-31, lines 54-65).

11. As per claim 6, Call teaches the method of claim 1 wherein the URI is a uniform resource locator (URL) (Col. 2, lines 45-48; Col. 15, lines 48-52).

12. As per claim 7, Call teaches the method of claim 1 wherein the selected content is only a portion of the web page (Col. 2, lines 22-25).

13. As per claim 8, Call teaches the method of claim 1 wherein the selected content is a digital asset (Col. 6, lines 48-55; Col. 17, lines 20-26).

14. As per claim 9, Call teaches the method of claim 1 wherein the selected content is an executable file (Col. 33, lines 24-27, lines 41-49).

15. As per claim 10, Call teaches the method of claim 1, wherein the script includes a subscriber identifier and a content identifier, and step (b) further comprises using the subscriber identifier and the content identifier to create the unique identifier of the selected content (Col. 5, lines 61-67; Col. 6, lines 1-10).

16. As per claim 11, Call teaches the method of claim 1 wherein the web page is constructed using HTML, and the script is embedded therein (Col. 11, lines 5-15).

17. As per claim 13, Call teaches a method of syndicating digital assets comprising:

(a) constructing a web page (Col. 11, lines 5-15); and

(b) inserting into the web page script associated with at least one digital asset that is desired to be part of a fully rendered web page, wherein the script, when executed by a browser, requests the content of the digital asset from a remote site, the request including a uniform resource identifier (URI) of a web page and a unique identifier of the selected content (Col. 2, lines 40-48; Col. 15, lines 39-52; Col. 17, lines 42-53, lines 65-67; Col. 18, lines 1-10, lines 52-58; Col. 21, lines 43-48).

18. As per claim 15, Call teaches a method of claim 13 wherein the selected content is an executable file (Col. 33, lines 24-27, lines 41-49).

19. As per claim 16, Call teaches a method of claim 13 wherein the script includes a subscriber identifier and a content identifier, which together, create the unique identifier of the selected content (Col. 5, lines 61-67; Col. 6, lines 1-10).

20. Claims 17 and 21 do not teach or define any new limitations above claim 13 and therefore are rejected for similar reasons.

21. Claims 19 and 23 do not teach or define any new limitations above claim 15 and therefore are rejected for similar reasons.

22. Claims 20 and 24 do not teach or define any new limitations above claim 16 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 12, 14, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Call, Charles G. (hereinafter Call), US 6,418,441, in view of Landsman et al. (hereinafter Landsman), US 6,314,451.

24. As per claim 12, Call does not explicitly teach the method of claim 1 wherein the script is JavaScript.

25. Landsman teaches a method of claim 1 wherein the script is JavaScript (Col. 11, lines 40-60).

26. It would have been obvious to one of ordinary skill in this art at the time of the invention was made to combine the teachings of Landsman and Call because they both deal with distributing content across a network to a browser from remote sites. Furthermore, the teaching of Landsman to allow wherein the script is JavaScript would improve the functionality of Call's system by allowing for dynamic writing of tags/identifiers in order to download and implement content pages all while remaining visually transparent to a user's browser.

27. Claims 14, 18 and 22 do not teach or define any new limitations above claim 12 and therefore are rejected for similar reasons.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Syndication Methodology To Dynamically Place Digital Assets On Non-Related Web Sites".

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|------|--------------|------------------------|
| i. | US 6,157,933 | Celi, Jr. et al. |
| ii. | US 6,625,581 | Perkowski, Thomas J. |
| iii. | US 6,118,768 | Bhatia et al. |
| iv. | US 5,640,193 | Wellner, Pierre David. |


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas A. Martin whose telephone number is (571) 272-3970. The examiner can normally be reached on Monday - Friday 8:30 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3970.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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December 21, 2004


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